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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/267,025	03/11/1999	RODNEY M. SHIELDS	TF-2018-03-R	6529
38598	7590	10-05/2004	EXAMINER	
ANDREWS KURTH L.L.P. 1701 PENNSYLVANIA AVENUE, N.W. SUITE 300 WASHINGTON, DC 20006			WATRINS III, WILLIAM P	
			ART UNIT	PAPER NUMBER

1772

DATE MAILED: 10/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/267,025	Applicant(s) SHIELDS, RODNEY M.	
	Examiner William P. Watkins III	Art Unit 1772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 January 2004 and 24 November 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5,7,9,11,12 and 22-70 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5,7,9,11,12 and 22-70 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input checked="" type="checkbox"/> Other: <u>See Continuation Sheet</u> . |

Continuation of Attachment(s) 6). Other: PTO Translation 99-5177 of DE 2,838,028.

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DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 24 November 2003 has been entered.

2. The original patent, or an affidavit or declaration as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178.

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3. Applicant is requested to supply a PTO Form 1449 listing the references printed on the face of the U.S. 5,609,938 parent patent in order that they may be printed on the face of the instant reissue patent, if the instant application is allowed, as required by current reissue practice.

4. Claims 1-5, 7, 9, 11-12, 22-70 are rejected under 35 U.S.C. 251 as being an improper recapture of claimed subject matter deliberately canceled in the application for the patent upon which the present reissue is based. As stated in *Ball Corp. v. U.S.*, 221 USPQ 289,295 (Fed. Cir. 1984): "The recapture rule bars the patentee from acquiring, through reissue, claims that are of the same or broader scope than those claims that were canceled from the original application".

The examiner has carefully examined the prosecution of the parent case. The limitation of a vision panel with a liner attached with a pressure sensitive adhesive means and the limitation of a non perforated backing layer were both added by applicant late in the prosecution of the parent case to overcome the applied art rejection. Also all claims were specifically limited to having the reflective coating and opaque coating on the same side of the transparent panel, opposite the adhesive

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layer, as this was the only configuration supported by Figures 6A and 6C which were in turn the only embodiment that supported a nonperforated backing layer behind a perforated protective liner. The examiner notes that all method claims were canceled in the parent case. All of the instant claims do not recite a pressure sensitive adhesive means, while claims 1, 3-5, 7, 9, 11-12, 22-67, and 69-70 do not recite a non perforated backing layer, while claims 22-42 have the reflective and opaque coatings on different sides of the transparent panel. The instant method claims 22-31, 43-49 and 62-66 also appear to be at least as broad in terms of a simultaneous perforation step as claims 64 and 66 of the '889 parent case which were canceled before allowance of the case. The absence of the above noted limitations in the instant claims as well as the lack of narrowing in the new method claims causes the instant claims to be either broader or at least as broad, regarding limitations material to overcoming the prior art rejections in the parent case, as the claims in the parent U.S. 5,609,938 patent. The instant claims thus involve recapture and are improper.

5. Claim 5 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the

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specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

It is not clear where this Markush group is supported in the original specification. See section VII below in the response to applicant's arguments.

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1, 5, 7, 9, 22, 24, 25, 26, 27, 28, 29, 30, 32, 34, 35-41 and 67 are rejected under 35 U.S.C. § 103 as being unpatentable over Hill (U.S. 4,673,609)

Hill teaches the basic concept of a panel which has an image that can be seen from the first side without an observer on the first side seeing the second side, with an observer on the second side being able to see through the panel to the first

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side (Figure 26(2), column 20, lines 30-35). The image may be reflective with an opaque layer on an opposite side (column 6, lines 55 through col. 7, line 10). The panel may screen U.V. light (column 3, line 1). The vision effects of the panel may be formed by use of a perforated panel with the perforations allowing sight through the panel and the non-perforated areas blocking vision, with a reflective image pattern on one side of the panel with the perforations with the panel being formed before or after the application of the reflective image (column 13, lines 37-49, claim 15 (reexam certificate issued July 25, 1995, attached to the back of the main reference)). The panel may have an attachment adhesive and a protective release layer (claim 15, reexam cert.). The perforated sheet (silhouette pattern) and image may be between transparent protective cover sheets (column 14, lines 1-10). The sheet with the silhouette pattern may be attached to a static cling film (which maybe colored or transparent), or may be a static cling film (column 14, lines 30-40, lines 50-65). The panel may have a mirror layer (col. 14, line 65 through col. 15, line 10). Multiple panels may be used to form the reflective and opaque layers (col. 14, lines 5-15). The instant invention claims a panel with reflective and absorbing coatings on the panel with the

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panel with the coatings being perforated in a single step. It would have been obvious to one of ordinary skill in the art to have formed the panel which is perforated in col. 13 of the reference, where the perforations provide vision through the panel, with either reflective and opaque coatings, or reflective and opaque or absorbing layers in order to enable the teachings of a perforated vision panel in column 13, because of the teaching of reflective and absorbing structures, in the rest of reference as being used to form the elements which provide the function of the vision panel. Using these material in a continuous manner with discontinuities forming the through vision areas would have been obvious given the disclosure in col. 13 to use perforations as the through vision areas instead of using these materials in a discontinuous manner and relying on space between the discontinuities to provide through vision. Perforation in one step of all layers that require through vision would also have been obvious in view of the teaching to perforate before coating of the image area. Variation in the number and position of protective and mounting layers would have been obvious to one of ordinary skill in the art given the teachings of Hill.

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8. Claims 3, 4, 23, 31-33, 42, 43, 44, 45 46-48, 49, 50, 51-56, 57-66, and 69-70 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hill '609 as applied to claims 1, 5, 7, 9, 22, 24, 25, 26, 27, 28, 29, 30, 32, 34, 35-41 and 67 above, and further in view of Frey (U.S. 1,199,882).

Frey teaches in Figure 2 the use of a staggered pattern of transparent areas in a panel which functions as a silhouette pattern that allows viewing from one side through the panel and a reflected image from the other side. The instant invention claims the use of a perforated opaque sheet with an image on one side that has staggered holes and holes of specified sizes. It would have been obvious to one of ordinary skill in the art to use transparent areas or holes in the panel of Hill in a staggered pattern because Frey teaches this pattern as a design choice for transparent areas in a viewing panel with the function of the Hill panel. A staggered pattern in the flexible embodiments of Hill would inherently give tearing resistance. The Frey pattern is presumed to have the open area % and hole size range of the instant claims since it allows enough light through the panel to allow viewing through the panel from the back side as does the pattern of the instant claims.

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9. Claims 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hill '609 as applied to claims 1, 5, 7, 9, 22, 24, 25, 26, 27, 28, 29, 30, 32, 34, 35-41 and 67 above, and further in view of Mallik (U.S. 5,128,779) and Rosenthal (U.S. 4,034,555).

Mallik teaches the use of a discontinuous hologram that is formed with many openings that allows a three dimensional image to be seen from some angles in front of the hologram and vision through the hologram (abstract, col. 11 lines 28-30, col. 4, lines 45-60, col. 9, lines 15-30, col. 11, lines 10-20).

Rosenthal teaches the use of a lenticular lens layer over an image in order to form a three dimensional image. The instant invention claims a vision panel with a hologram and lenticular lens. It further would have been obvious to enhance the image of Hill by the use of a perforated hologram to provide a three dimensional effect for the image layer because of the teachings of Mallik. It further would have been obvious to use a lenticular lens system as an alternative to a hologram in order to form a three dimensional effect because of the teachings of Rosenthal.

10. Claims 2 and 68 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hill (U.S. 4,673,609) as applied to

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claims 1, 5, 7, 9, 22, 24, 25, 26, 27, 28, 29, 30, 32, 34, 35-41 and 67 above, and further in view of Bogner (DE 28 38 028).

Hill teaches perforated image, adhesive and liner layers which may be flexible and further printed after perforation (col. 13, 30-35, 40-45). Bogner teaches applying a nonperforated backing layer to permeable fabric layer in order to allow the fabric layer to be better handled by various printing machines. The instant invention claims the use of a perforated image and liner layer with a nonperforated backing. It would have been obvious to one of ordinary skill in the art to use a nonperforated backing layer on the perforated image and liner layers of Hill in order to allow handling of the perforated combination during further printing because of the teachings of Bogner.

11. Applicant's arguments filed 24 November 2003 have been fully considered but they are not persuasive. The responses below follow the section headings in the amendment filed 24 November 2003.

I. The power of attorney has been accepted.

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II. The objection regarding the consent of the assignee is withdrawn in view of the new consent form that has been filed.

III. Noted.

IV. No 1449 is attached to the amendment. The request is repeated.

V. Noted.

VI. The examiner maintains the position that *In re Clement*, 45 USPQ2d 1161 (Fed. Cir 1997) controls the facts of this case. The examiner does not state a per se rule that no recapture of surrendered subject matter is allowed, but instead is of the position that applicant's actions in this case are an admission that the scope of the claims abandoned were in fact not patentable. As stated by the examiner on page 9 of the office action mailed 24 September 2003 limitations were "added by applicant late in the prosecution of the parent case to overcome the applied art rejection". The cases cited by applicant can be distinguished from the instant facts. In *Seattle Box v. Industrial*, 221 USPQ 568, 571 (Fed. Cir. 1984) "neither the

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patent examiner nor the cited prior art required the narrow scope of the issued claims". This is not true in the instant case were the examiner applied art that was avoided by applicant's amendment that narrowed the claim. In *In re Wilder et al.*, 222 USPQ 369, 371 (Fed. Cir. 1984), also is not on point in that the original claims were overly narrow because no patentability search had been preformed. The mistake of the attorney was to presume the results of a patentability search before writing the original claims, not in allegedly misjudging the strength of an obviousness rejection and amending the claims as in the instant application. The position of the examiner is that *Morey v. Lockwood*, 75 U.S. 230 (1868), can also be distinguished from the instant facts. In *Morey* the patent office cited a printed publication that represented an actual machine being marketed that was silent on the nature of the tubing used. The office presumed the tubing was flexible and suggested applicant add a further limitation. Latter it was shown that the actual tubing of the prior art was metal and that the publication cited could therefore not have taught flexible tubing. The office admitted this actual error involving the description of an actual machine that was relied upon by inference as prior art. The office has admitted no error in

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this case. Claim 15 of the Reexam Certificate of Hill '609, has been found to be supported in the original specification of Hill '609 by both the Reexam examiner and the examiner of the reissue of Hill '609 (RE37186). Claim 15 of Hill '609 was applied against the claims of the instant parent application (office action mailed 23 August 1995 in the 08/324,889 parent), before applicant amended the narrowing limitations into the claims of the parent. At best, if there is error on the part of applicant, it is the failure to press the current arguments that claim 15 of Hill '609 is not supported in the original specification of Hill '609 in the instant parent application and instead deciding to narrow the claims. This narrowing is a classic example of the intent of the applicant at the time to abandon the original subject matter as unpatentable, which is the basis of the recapture prohibition doctrine.

VII. The rejection is maintained. Applicant is asked to point exactly which passages of the patent support each individual member of the Markush group. A cursory review of the passages cited by applicant indicated that most are drawn to light and dark coatings without reference to these coatings being adhering means.

VII. Noted.

IX. The 112 antecedent basis rejection is withdrawn in view of applicant's amendments.

X. Applicant presents the argument that Hill '609 claim 15 is new matter to the original specification of Hill '609. As noted above in the recapture section PTO examiners in the Reexam and Recessue proceeding regarding Hill '609 have twice addressed this argument and support for the claim has been found. At best applicant argues that a preponderance of multiple bits of evidence contradicts the findings of the PTO examiners in the Hill cases. The claims of the Hill Reexam have a presumption of validity absent clear and convincing evidence to the contrary.

At page 22 of the instant amendment applicant argues that, at best, the passage (col. 13) argued by Hill to support claim 15 as not being new matter may render claim 15 obvious but not supported under the written description requirement. The examiner notes that as regards the instant art rejection, the original specification of Hill '609 supporting claim 15 of Hill '609 as being obvious, would render the instant claims obvious

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over the original specification of Hill, even if claim 15 of Hill is new matter in Hill.

The art rejection in section 19 of the office action mailed 24 September 2003, in the instant case, lays out the rationale that transparent areas can be formed through the reflective and absorptive layers of a panel by perforation through all of these layers as taught in col. 13 of Hill '609. Though col. 13 of Hill does not teach external adhesive layers and release liners, these features are present in many of the nonperforated embodiments of Hill '609 and would be obvious to use with the perforated embodiments taught in Hill '609 as the same type of final mounted application is taught for both perforated and non-perforated embodiments. As an adhesive that joins the vision panel to a window would have to have transparent areas in alignment with the transparent areas formed by the perforations of the vision panel, it would have been obvious to also form those transparent areas by perforation, as this is a method clearly taught to form transparent areas in col. 13 of Hill '609. In column 13 of Hill, perforation before or after coating of a design is taught. Perforation after a design is coated would involve simultaneous perforation of the coating and base panel substrate. This teaches the concept of simultaneous

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perforation, which would be easily applied to other needed layers that require perforation such as adhesive layers. Thus the position of the examiner remains that the instant claims are obvious over Hill '609.

XI. Applicant argues no motivation to combine. The rejection is based on substitution of structures, which have similar functions in similar applications being within the ordinary skill of the art.

XII. Applicant argues no motivation to combine. The motivation to provide a three dimensional effect is given.

XIII. Applicant argues nonanalogous art. Bogner deals with a common problem, which is manipulation of sheets that need to have designs printed on them.

12. All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114.

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Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William P. Watkins III whose telephone number is 571-272-1503. The examiner works an increased flex time schedule, but can normally be reached Monday through Friday, 11:30 A.M. through 8:00 P.M. Eastern Time. The examiner returns all calls within one business day unless an extended absence is noted on his voice mail greeting.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in cursive script, reading "William P. Watkins III".

WW/ww

August 4, 2004

WILLIAM P. WATKINS III
PRIMARY EXAMINER